

REMARKS/ARGUMENTS

Claims 1-5 are pending in the application. Applicants have amended claim 2 to improve its clarity. The amendment is not considered to be a narrowing amendment. Support for the amendment is found at page 16, lines 4-18; page 19, lines 11-16; page 20, lines 25-30; and elsewhere in the application. No new matter has been added.

In the Office action, the Examiner rejected claims 1-5 under 35 USC § 103(a) as being unpatentable over Miller in view of Freedman et al. and Yamamoto et al. Applicants respectfully traverse the rejection.

The present divisional application is directed to a *method* of forming an ink-receptive substrate. Claim 1 is the sole independent claim and recites:

1. A method for forming an ink-receptive substrate comprising the steps of:

forming a melt-processable base layer from a water-insoluble thermoplastic polymer; and

simultaneously forming an ink-receptive layer over the base layer from a blend of a water-soluble polymer and a substantially water-insoluble polymer, wherein the ink-receptive layer provides a printable surface that is inherently ink-receptive without subsequent treatment.

In the Office action, the Examiner states that "Miller teaches the basic claimed process of forming an ink-receptive substrate. . ." In fact, Miller does *not* teach the basic steps recited in Applicants' claims. In particular, claim 1 of the present application calls for forming a melt-processable base layer from a water-insoluble thermoplastic polymer; and *simultaneously forming* an ink-receptive layer over the base layer. . ." Miller describes ink-receptive film compositions, but not the simultaneous formation of an ink-receptive layer and a base layer. Rather, at column 6, lines 8-13, Miller discloses that "[t]he receptor layer can be applied to the film backing by any conventional coating technique, e.g., deposition from a solution or

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dispersion of the resins in a solvent or aqueous medium, or blend thereof, by means of such processes as Meyer bar coating, knife coating, reverse roll coating, rotogravure coating, and the like." In other words, Miller starts with a film backing, coats it with a composition, and then dries the composition to form an ink-receptive layer on the base film. Simultaneous formulation of an ink-receptive layer and a base layer is neither taught nor suggested.

Accordingly, since Miller does not teach the simultaneous formation of a melt-processable base layer and an ink-receptive layer over the base layer, the rejection of Applicants' claims under 35 U.S.C. § 103(a) should be withdrawn.

The Examiner has not indicated how Miller, taken in combination with Yamamoto et al., leads to the presently claimed invention. In particular, there is no showing that the combined references lead to a method of forming an ink-receptive substrate in which an ink-receptive layer is simultaneously formed with a base layer.

The Examiner has cited the Freedman et al. reference for its disclosure of coextruding a film having a tie layer, and for its disclosure of forming an adhesive layer on the back surface of a film. The Freedman et al. reference is, at most, citable as a §103/102(e) reference, as it was published on October 10, 2002 -- *after* the filing date of Applicants' parent application, no. 09/547,942, filed April 11, 2000. The present application is a divisional of the '942 application. As explained below, Freedman et al. cannot be cited against the pending application.

Under 35 U.S.C. § 103(c)(1) "Subject matter developed by another person, which qualifies as prior art only under one or more of the subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Both the Freedman et al. reference and the present application were, and are, commonly owned. The Freedman et al. reference is a continuation of Application No. 09/062,203, filed on April 17, 1998 (now U.S. patent no. 6,461,706). The '203 application was assigned in 1998 to Avery Dennison Corporation, along with "all . . . continuation. . . applications." The assignment is attached hereto as Exhibit A. Similarly, the present application was also assigned to Avery Dennison Corporation, pursuant to

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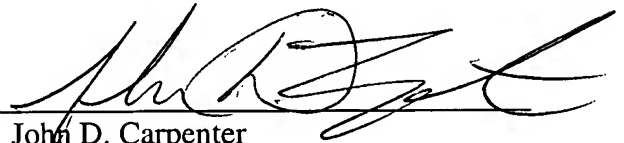
the assignments recorded at Reel 011032/Frame 0472 and Reel 011997/Frame 0410 submitted during prosecution of the present application's parent, Application No. 09/547,942. Copies of those assignments are attached hereto as Exhibit B. Accordingly, the Freedman et al. reference is not citable against this application.

For the foregoing reasons, Applicants respectfully request reconsideration and an early Notice of Allowance.

Respectfully submitted,

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